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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,472	07/24/2001	Mark F. McCarthy	NUTRI.018RA	5647

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EXAMINER
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COOK, REBECCA

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/912,472

Applicant(s)

MCCARTHY, MARK F.

Examiner

Rebecca Cook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/17/02.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 17, 2002 has been entered.

Claims 1-26 are pending.

### **35 U.S.C. 251**

Upon reconsideration the earlier rejection under 35 USC 251 is withdrawn.

Claims 11-23 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

No support is seen in the specification for the word "or" that has been added to claim 11.

### **CFR 1.173(b)(2)**

The amendment is improper, since it does not comply with CFR 1.173(b)(2).

### ***Claim Rejections - 35 USC § 112***

Claims 11-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No support is seen in the specification for the word "or" as it is used in the recitation "A method for reducing hyperglycemia **or** [emphasis added] stabilizing the level of serum glucose...."

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No support is seen in the written description for the phrase "greater than additive effect".

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "greater than additive effect" is unclear, since it is not clear in the composition claims what the effect is and in all the claims it is not clear what the additive effect is greater than.

### ***Claim Rejections - 35 USC § 103***

Claims 10 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,635,535, (Wagstaff).

Wagstaff discloses vitamin compositions comprising chromium picolinate or biotin. The claims differ over Wagstaff in requiring both chromium picolinate and biotin in the same composition. Claim 25 differs over Wagstaff in reciting higher amounts of

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each compound. However, no unobviousness is seen in combining biotin and chromium picolinate in one composition, since each is taught to be useful as a food supplement. Furthermore, in the absence of a showing of unexpected results, no unobviousness is seen in a composition that uses higher amounts of these compounds.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson and Maebashi et al. Anderson (abstract) discloses that 500 mg of orally administered chromium picolinate is useful in stabilizing the amount of serum glucose and reducing hyperglycemia in humans. Maebashi (abstract) discloses that 9 mg daily of orally administered biotin reduces hyperglycemia and stabilizes serum glucose in humans. No unobviousness is seen in combining the two compounds to form a composition useful for a method of reducing hyperglycemia and/or stabilizing serum glucose, since each is taught in the art to be useful for the same purpose. The instant claims recite that the combination provides a greater than additive effect. However, it would be inherent that combining Anderson and Maebashi would yield a greater than additive effect, since the amounts they use are the same or greater than the instantly recited amounts.

Dependent claims recite parenteral administration. However, in the absence of a showing of unexpected results, no unobviousness is seen in parenteral administration, which is well-known in the pharmaceutical art. The claims further differ over Maebashi in reciting different amounts of biotin. However, in the absence of a showing of unexpected results, no unobviousness is seen in using different amounts of biotin, since

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once the effect of a compound is known in the art it is within the skill of the artisan to determine the optimum amount to use.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,789,401. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method for reducing hyperglycemia and stabilizing the level of serum glucose using a composition of chromium and biotin and said composition render the instant method for reducing hyperglycemia or stabilizing the level of serum glucose using a composition of chromium and biotin and said composition obvious, since the instant amounts of chromium and biotin overlap the amounts recited in '401 .

### **Original Patent**

The original patent was surrendered in the submission of July 24, 2001.

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### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cook whose telephone number is (571) 272-0571. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (571) 272-0951.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Renee Jones (571) 272-0547 in Customer Service.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The official fax number is 703-872-9806

Rebecca Cook



Primary Examiner  
Art Unit 1614

November 9, 2004